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Federal Agencies

February 16, 2005

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Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Art Unit 1634

Re: U.S. Utility Patent Application
Application No. 09/695,065; Filed: October 25, 2000
For: **Methods of Manipulating and Sequencing Nucleic Acid Molecules
Using Transposition and Recombination**
Inventors: BRASCH *et al.*
Our Ref: 0942.50000001/RWE/BJD/T-M

Sir:

Transmitted herewith for appropriate action are the following documents:

1. SKGF Cover Letter;
2. Eighth Supplemental Information Disclosure Statement;
3. Two (2) pages of Form PTO-1449;
4. A copy of cited document nos. **AO24, AT213, AR214 and AS214**; and
5. One (1) return postcard.

It is respectfully requested that the attached postcard be stamped with the date of filing of these documents, and that it be returned to our courier. In the event that extensions of time are necessary to prevent abandonment of this patent application, then such extensions of time are hereby petitioned.

Commissioner for Patents
February 16, 2005
Page 2

The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

A handwritten signature in black ink, appearing to read "Brian J. Del Buono", written over a horizontal line.

Brian J. Del Buono
Attorney for Applicants
Registration No. 42,473

BJD/T-M/nef
Enclosures

362103_1.DOC

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Brasch *et al.*

Appl. No. 09/695,065

Filed: October 25, 2000

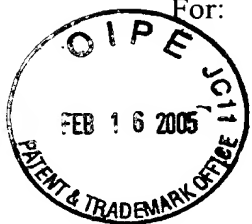
For: **Methods of Manipulating and
Sequencing Nucleic Acid
Molecules Using Transposition
and Recombination**

Confirmation No. 1682

Art Unit: 1634

Examiner: Lu, Frank W.M.

Atty. Docket: 0942.5000001/RWE/BJD/T-M



Eighth Supplemental Information Disclosure Statement

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450
Sir:

Listed on accompanying Form PTO-1449 are documents that may be considered material to the examination of this application, in compliance with the duty of disclosure requirements of 37 C.F.R. §§ 1.56, 1.97 and 1.98.

The numbering on this Eighth Supplemental Information Disclosure Statement is a continuation of the numbering in Applicants' Seventh Supplemental Information Disclosure Statement filed January 27, 2005, in connection with the above-captioned application.

Copies of documents **AB22-AK22** and **AA23** are not provided in accordance with the Changes To Support Implementation of the United States Patent and Trademark Office 21st Century Strategic Plan, effective October 21, 2004, which states "section 1.98(a)(2)(i) is amended to eliminate the requirement in paragraph (a)(2)(i) for a copy of each U.S. patent or U.S. patent application publication listed in an IDS in a patent application regardless of the filing date of the application." A copy of each other document is provided.

Where the publication date of a listed document does not provide a month of publication, the year of publication of the listed document is sufficiently earlier than the effective U.S. filing date and any foreign priority date so that the month of publication is not in issue. Applicants have listed

Brasch *et al.*
Appl. No. 09/695,065

publication dates on the attached Form PTO-1449 based on information presently available to the undersigned. However, the listed publication dates should not be construed as an admission that the information was actually published on the date indicated.

Applicants reserve the right to establish the patentability of the claimed invention over any of the information provided herewith, and/or to prove that this information may not be prior art, and/or to prove that this information may not be enabling for the teachings purportedly offered.

This statement should not be construed as a representation that a search has been made, or that information more material to the examination of the present patent application does not exist. The Examiner is specifically requested not to rely solely on the material submitted herewith.

This Information Disclosure Statement is being filed before the mailing of a first Office Action after the filing of a Request for Continued Examination under 37 C.F.R. § 1.114. No statement or fee is required.

It is respectfully requested that the Examiner initial and return a copy of the enclosed Form PTO-1449, and indicate in the official file wrapper of this patent application that the documents have been considered.

The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



Brian J. Del Buono
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360331_1.DOC

FORM PTO-1449

**EIGHTH SUPPLEMENTAL
INFORMATION DISCLOSURE STATEMENT**

 ATTY. DOCKET NO.
0942.5000001/RWE/BJD/T-M

 APPLICATION NO.
09/695,065

 APPLICANT(S)
Brasch *et al.*

 FILING DATE
October 25, 2000

 ART UNIT
1634

U.S. PATENT DOCUMENTS

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUB-CLASS	FILING DATE
	AA						
	AB22	6,040,138	03/21/2000	Lockhart <i>et al.</i>			09/15/1995
	AC22	6,303,301	10/16/2001	Mack			05/29/1998
	AD22	6,309,822	10/30/2001	Fodor <i>et al.</i>			12/23/1996
	AE22	6,333,155	12/25/2001	Lockhart <i>et al.</i>			12/18/1998
	AF22	6,544,790	04/08/2003	Sabatini			09/18/2000
	AG22	2002/0162126	10/31/2002	Beach <i>et al.</i>			05/24/2001
	AH22	2003/0135888	07/17/2003	Zhu <i>et al.</i>			09/26/2002
	AI22	2003/0175772	09/18/2003	Wang			12/26/2002
	AJ22	2004/0229229	11/18/2004	Cheo <i>et al.</i>			08/14/2003
	AK22	2004/0265863	12/30/2004	Chesnut <i>et al.</i>			03/04/2004

FOREIGN PATENT DOCUMENTS

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUB-CLASS	TRANSLATION
	AL						Yes No
	AM						Yes No
	AN						Yes No
	AO24	WO 01/68836	09/20/2001	WIPO			Yes No
	AP						Yes No

OTHER (Including Author, Title, Date, Pertinent Pages, etc.)

	AR		
	AS		
	AT	<u>213</u>	Baum, J.A., "Tn5401, a New Class II Transposable Element From <i>Bacillus thuringiensis</i> ," <i>J. Bacteriol.</i> 176:2835-2845, American Society for Microbiology (1994)

EXAMINER

DATE CONSIDERED

EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to Applicant.

FORM PTO-1449

**EIGHTH SUPPLEMENTAL
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ATTY. DOCKET NO.
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1634

U.S. PATENT DOCUMENTS

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUB-CLASS	FILING DATE
	AA23	2005/0009091	01/13/2005	Hartley <i>et al.</i>			08/19/2004
	AB						
	AC						
	AD						
	AE						
	AF						
	AG						
	AH						
	AI						
	AJ						
	AK						

FOREIGN PATENT DOCUMENTS

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUB-CLASS	TRANSLATION
	AL						Yes No
	AM						Yes No
	AN						Yes No
	AO						Yes No
	AP						Yes No

OTHER (Including Author, Title, Date, Pertinent Pages, etc.)

	AR	<u>214</u>	Office Action for U.S. Patent Application No. 10/796,868, mailed on January 25, 2005
	AS	<u>214</u>	Short, J.M., <i>et al.</i> , "λ ZAP: a bacteriophage λ expression vector with <i>in vivo</i> excision properties," <i>Nucleic Acids Res.</i> 16:7583-7600, Oxford University Press (1988)
	AT		

EXAMINER

DATE CONSIDERED

EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to Applicant.